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EXAMINER

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3711

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/248,515
Filing Date: February 08, 1999
Appellant(s): SOSIN, HOWARD B.

Charles E. Lyon, D.Phil
For Appellant

EXAMINER'S ANSWER

MAILED
AUG 23 2004
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This is in response to the appeal brief filed 6 July 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. It is stated as saying a listing of pending claims 50-54 and 59-69 is provided as Attachment I. There is nothing in the Brief which has Attachment I written on it. There is an attachment titled "Claims Pending before Entrance of Amendment". These claims are the correct claims pending for this case.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 6 July 2004 has not been entered due to the case being in an After Final condition and additional words have been added which were not included before. This would require as a minimum further consideration. Additionally now there are two sets of claims added to the Brief. It is stated as

Attachment I is the claims before the after final office action and Attachment II is the claims after the entrance of the Amendment which I assume being discussed is amendment dated 6 July 2004. These two different sets of claims do not have the title of Attachment I and Attachment II and have the same page numbers. The claims titled "Claims Pending before Entrance of Amendment" are the correct claims pending for this case. The claims titled "Claims Pending after Entrance of Amendment" are not pending for this case since the amendment filed 6 July 2004 was not entered.

(5) *Summary of Invention*

The appellant's statement of the issues in the brief is substantially correct. The examiner however does not agree with the statement that traditional golf clubs did not have a club face at an intended design loft with the shaft held in a non-vertical position. This is our difference of positions which we are arguing.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 50-54 and 59-69 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

Claims titled "Claims Pending after Entrance of Amendment" contain(s) substantial errors as presented in the Appendix to the brief since it is based on an after final dated 6 July 2004 which was not entered. Accordingly, claims titled "Claims Pending before Entrance of Amendment" in the Brief is the correct set of claims on appeal.

(9) Prior Art of Record

3,961,796	THOMPSON	6-1976
5,120,062	SCHEIE	6-1992
5,564,991	HIROSE	10-1996
5,971,866	ADAMS	10-1999
6,015,354	AHN	1-2000

The following is the prior art not relied on but cited as to develop what is known in the art by one skilled in the art at the time of the invention. The examiner used these findings to conclude the meaning of prior art references relied on to persons of ordinary skill in the art and the motivation those references would provide to such persons (In re Berg, 65 USPQ2d 2003 (Fed. Cir. 2003)).

5,536,012	D'AMICO	7-1996
5,224,702	TURNER	7-1993
4,157,830	TAYLOR	6-1979
5,199,707	KNOX	4-1993

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5,989,132	MACDONALD	11-1999
3,332,684	SOLHEIM	7-1967
4,915,386	ANTONIOUS	4-1990
5,921,869	BLOUGH	7-1999
1,657,473	HOWARD	1-1928
5,547,196	IZETT	8-1996
5,421,098	MULDOON	6-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 51, 53-54, and 59-69 stand rejected under 35 U.S.C. 102(b) as being anticipated by Thompson.

Thompson discloses an iron-type golf club having a head with a sole, a single design loft (Fig. 2), a single straight hosel for connection to a shaft (Figs. 1-2), a connection arranged so that the shaft forms a non-zero lean angle with the vertical when the head rests on its sole in the form of when the head is rested along the bottom on the sole (Fig. 2), the non-zero lean angle being greater than 3 degrees in the form about 6 degrees (Fig. 2), an iron being a wedge (Col. 2, Lns. 8-16), and when a head rests on its sole an impact face is positioned at its designed loft (Fig. 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 50 and 52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Scheie.

Thompson lacks a head and hosel being forged or cast. Scheie discloses a head and hosel being forged or cast (Col. 4, Lns. 1-2). In view of the patent of Scheie it would have been obvious to modify the club of Thompson to have the head and hosel being forged or cast in order to utilize a known manufacturing process in the market place.

5. Claims 50-54, 59-60, and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn view of Hirose and Scheie.

Ahn discloses a single design loft, a single straight hosel, a non-zero lean angle, and a lean angle being greater than 3 and less than 10 (Fig. 5).

Ahn lacks a single straight shaft and head and hosel being formed by forging or casting. Hirose discloses an iron club having a single straight shaft (Figs. 13-14, Col. 1, Lns. 10-25). In view of the patent of Hirose it would have been obvious to modify the club of Ahn to have a single straight shaft in order to increase the velocity of the head at impact. Scheie discloses a head and hosel being forged or cast (Col. 4, Lns. 1-2). In view of the patent of Scheie it would have been obvious to modify the club of Ahn to have the head and hosel being forged or cast in order to utilize a known manufacturing process in the market place.

6. Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn view of Hirose and Scheie as applied to claims 50-54, 59-60, and 67-68 above, and further in view of Adams.

Ahn lacks a wedge type head. Adams discloses a head having a wedge type loft with a lean angle (Col. 2, Lns. 16-27, Figs. 3-5). In view of the patent of Adams it would have been obvious to modify the head of Ahn to include a wedge type head in order to utilize the advantages of Ahn for a wedge type head.

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7. Claim 61-63, 66-67, and 69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Hirose.

Adams discloses an iron-type golf club having a head with a sole (Fig. 2), a single straight hosel for connection to a shaft (Figs. 1-2), a connection arranged so that the hosel forms a non-zero lean angle with the vertical when the head rests on its sole in the form of when the head is rested along the bottom on the sole (Figs. 3-5), the non-zero lean angle being greater than 3 degrees in the form about 8 degrees (Fig. 5), an iron being a wedge (Col. 2, Lns. 16-27), and when a head rests on its sole an impact face is positioned at its designed loft (Figs. 3-5).

Adams lacks a single straight shaft. Hirose discloses an iron club having a single straight shaft (Figs. 13-14, Col. 1, Lns. 10-25). In view of the patent of Hirose it would have been obvious to modify the club of Adams to have a single straight shaft in order to increase the velocity of the head at impact.

Response to Arguments

8. The argument that Thompson is improper due to Thompson not having a specific description of figure 2 relating to the shaft/head connection and as such those of ordinary skill would understand the club is a standard wedge and thus would not have a lean angle is disagreed with. The more the examiner searches the more woods/irons are found with lean angles. See the conclusion below as well as previous cited art. Lean angle is known in the art and one skilled in the art would know looking at figure 2

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that both a lean angle as shown or modifying the lean angle and making it zero are known teachings in the art. The argument that lean angle is a radical departure from the standard is disagreed with. The numerous references cited so far in this case show that the design of a lean angle is known in the art. The argument that figures 2 of Thompson is not drawn to scale or with angular precision and as such it reasonably discloses and suggest to one of ordinary skill in the art of a zero lean angle is disagreed with. Numerous references disclosed have shows significant lean angles as those cited in the conclusion below which can only imply there is a lean angle which is not zero. The lean angle in figure 2 is large enough that combined what is known in the art would lead one of ordinary skill in the art to conclude a positive lean angle as well as modifying the iron for a zero lean angle. The arguments with respect to Ahn are disagreed with the same response as stated above for the drawings of Thompson.

(11) Response to Argument

In the arguments filed 6 July 2004, the appellant argues:

1. The rejection is improper due to the references now cited by the examiner not referencing lean angle and only a tiny portion of a shaft is disclosed. The examiner offers no evidence that the prior art disclosure intended to represent a golf club with a lean angle.

2. The rejection is improper since the examiner selects his opinion over the proffered evidence offered by two different experienced golf club manufactures.
3. The reference of Thompson is improper since there is no discussion relating to any of the figures that addresses the shaft/head connection and one of ordinary skill would understand that it is a standard wedge and the Declarations and other evidence show a standard wedge has having a zero lean angle. Lean angle is a radical departure from the standard.
4. The rejection using Thompson is improper since the Examiner did not properly explain why the evidence is insufficient supplied by the Hamford Declaration.
5. The rejection using Thompson is improper since those of ordinary skill in the art would have understood it to be merely an inaccurate representation of a standard club. There is no indication that the figures are drawn to scale, or with angular precision.
6. The rejection using Thompson is improper since the Loesch Declaration has concluded that figure 2 is not intended to be an accurate scaled drawing and does not teach a lean angle. In addition the examiner failed to consider the declaration.
7. The previous cited art did not teach lean-angle containing clubs as recited by the claims and as such the examiner has had to continue keep searching.

8. The combination of Scheie with Thompson is improper since Scheie does not discuss a connection between a head and a shaft and no shaft is depicted anywhere in Scheie.

9. The rejection using the reference of Ahn is improper due to Ahn not discussing the desirability of a lean angle.

10. The rejection using the reference of Ahn is improper due to no dimensions are given, the ground is not indicated, and only a tiny portion of a shaft is shown. The figure is an inaccurate rendering of a standard club.

11. The rejection using the reference of Ahn is improper due to the purported lean angle being outside claimed range for claims 53 or 66 as shown by the Attachment III.

12. The rejection using the reference of Ahn is improper due to examiner discussing Ahn together with a reference by Solhiem in Office Action mailed May 22, 2003 and than the examiner dropping the reference to Solheim in the Final Office Action (11/14/03) which is a telling omission.

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13. The rejection using the reference of Ahn is improper since in the Final Office Action (11/14/03) the examiner replaced Solheim with Hirose and Hirose discloses a straight shaft and combined with the no lean angle head of Ahn.

14. The rejection combining reference of Ahn and Hirose is improper since one skilled in the art would much more likely select the standard no-lean-angle connection of Hirose rather than the 15 degree "lean angle" of Ahn.

15. The rejection using the reference of Adams in view of Hirose is improper since the head presently claimed have a single design loft.

16. In the Final Office Action (11/14/03), the examiner did not respond to the Appellant's prior comments with respect to Adams.

17. The cited by not relied reference of D'Amico does not show a lean angle but a golfer using a standard club in a swing that de-lofts the club.

18. In the Advisory Action the examiner seems to recognize that D'Amico shows a golfer actively delofting a standard club not a club with a lean angle by the statement "Clearly there is an angle between the shaft and vertical which the golfer is leaning the shaft to".

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19. The examiner suggestion that a sole flat would be obvious to have for a repeatable stance causing confusion to the appellant since this would not lead to a lean angle but a flat sole with a zero lean angle since the head face and shaft would be unchanged from a standard club. A flat sole and lean angle would completely destroy the original intended relationship between the face and sole of a head.

20. It is improper to conclude that D'Amico is teaching a lean angle since D'Amico specifically teaches standard long irons in column 4 lines 42-58.

21. Appellant does not see how adding a lean angle would assist golfers in achieving a repeatable stance.

22. The reference of Blough and five by Antonious are not accurate, scaled depictions. If taken accurate, lean angles of 25 or greater would be achieved. None would show a lean angle of 3-10 degrees.

23. With respect to item 1, the arguments that the rejection is improper due to the references now cited by the examiner not referencing lean angle with only a tiny portion of a shaft is disclosed and the examiner offers no evidence that the prior art disclosure intended to represent a golf club with a lean angle are disagreed with. These references do refer to a lean angle by their drawings. Just because a concept is not described in words does not mean it isn't referred to or doesn't exist. Thompson clearly

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shows the resting surface (Ref. No. 34, Fig. 2) and the club designed to lay flat on the resting surface (Col. 3, Lns. 17-18) and the hosel and shaft being at an angle to the vertical plane. In figure 4 of Thompson, Thompson was able to show the loft to which appears to a vertical which is different from the orientation seen in figure 2. Adams clearly refers to a lean angle by figures 3-5. Clearly the shaft with a different shape is not going to be replaced in the head each time one of the different orientations is going to be used, therefore one of the orientations of the heads shown in Figures 3-5 will have a lean angle. The disclosures does not specifically state in words the concept but clearly it is inherently implied and exists as shown in the drawings. Ahan shows a flat sole surface with a shaft oriented from a vertical plane (Figs. 2, 5, 9, and 12). Other prior art references which have been use during the prosecution of this case as Knox (Fig. 3) and D'Amico (Fig. 1B) also show a lean angle designed in a club as shown by the drawings though not specifically refer to it in the written description. If lean angle is so radical than why did not Adams, D'Amico or Knox discuss it in their written disclosures? It is because this concept is shown with the drawings and it is not so radical that it needs to be discussed.

24. With respect to item 2, the argument that the rejection is improper since the examiner selects his opinion over the proffered evidence offered by two different experienced golf club manufactures is disagreed with. An examiner's job with respect to a declaration is consider declarations in light of all over evidence which was done in this case. Prior art and what was known by one skilled in the art of the time of the

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invention also play a roll in the examiner coming to a judgment as whether a declaration is persuasive to overcome a rejection. It would be wrong to only place weight on what was presented in declarations. In this instant considering all other teachings of prior art the examiner concluded that the declaration was not persuasive to overcome the rejection.

25. With respect to item 3, the argument that reference of Thompson is improper since there is no discussion relating to any of the figures that addresses the shaft/head connection and one of ordinary skill would understand that it is a standard wedge and the Declarations and other evidence show a standard wedge has having a zero lean angle is disagreed with. See item 23 above.

26. With respect to item 4, the argument that the rejection using Thompson is improper since the Examiner did not properly explain why the evidence is insufficient supplied by the Hamford Declaration is disagreed with. The examiner did explain in the Advisory Action dated 22 March 2004 why the evidence was not sufficient. More specifically the evidence is insufficient since in the declaration it is stated in page 2 of 5 paragraph 5 that all golf clubs today are designed and constructed so that, that at the time of manufacture, they have a zero lean angle which is a shaft will not be perpendicular to the ground at the time of impact. The examiner clearly does not agreed with this statement due to the disclosures of Solheim (3,332,684, Fig. 1), Howard (1,657,473, Fig. 2), Taylor (4,157,839, Fig. 3), Turner (5,224,702, Fig. 5), D'Amico (5,536,012, Fig.

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1B), Knox (5,199,707, Fig. 3), Adams (5,971,866, Figs. 3-5), Thompson (3,961,796, Fig. 2), and Ahn (6,015,354, Fig. 2). The prior art evidence is counter to the conclusion disclosed in the Hamford Declaration.

27. With respect to item 5, the argument that the rejection using Thompson is improper since those of ordinary skill in the art would have understood it to be merely an inaccurate representation of a standard club and there is no indication that the figures are drawn to scale, or with angular precision is disagreed with. In "In re Seid, 73 USPQ 431" it is reinforced that an accidental disclosure, if clearly made in a drawing, is available as a reference. Figure 2 of Thompson by itself or if combined with figure 4 where a vertical line is shown to show a loft clearly shows figure 2 to have a lean angle. Though accidental as it may be the courts have ruled that this type of disclosure is allowed to be available as a reference. Combined with the knowledge of what is available as prior art to one skilled in the art as discussed in item 26 above, it would clearly make it obvious to have a lean angle as one of the possibilities for the club of Thompson.

28. With respect to item 6, the argument that the rejection using Thompson is improper since the Loesch Declaration has concluded that figure 2 is not intended to be an accurate scaled drawing and does not teach a lean angle is disagreed with. It is agreed the examiner failed to consider the declaration. In the declaration it is stated that an iron or wedge with a non-zero lean angle has never been seen. Solheim (3,332,684,

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Fig. 1), D'Amico (5,536,012, Fig. 1B), Knox (5,199,707, Fig. 3), Adams (5,971,866, Figs. 3-5), and Ahn (6,015,354, Fig. 2) all show an iron or wedge type head with a lean angle. So this first statement is not persuasive. In the declaration it also states that it would be expected that a picture intended to illustrate a lean angle would discuss it extensively since this concept is so unusual. This statement is not persuasive since other patents have a lean angle to do not discuss it extensively either. See item 23 above. Finally it is stated in the declaration the figure itself could be construed to depict a lean angle but instead it is an imprecise rendition of a three-dimension object in two dimension rather than. This statement is not persuasive due to the conclusion of "In re Seid, 73 USPQ 431". See item 27 above.

29. With respect to item 7, the appellant argues that the previous cited art did not teach lean-angle containing clubs as recited by the claims and as such the examiner has had to continue keep searching. The appellant has continued to modify the claims to be more narrow so that woods with lean angles (Taylor (4,157,839, Fig. 3), Turner (5,224,702, Fig. 5)), irons with non-straight hosels having lean angles (Knox (5,199,707, Fig. 3)), wedge with multiple hosels and shafts with lean angles (Izett (5,547,196, Fig. 2), clubs with non-straight shafts (Howard (1,657,473, Fig. 2)), irons with multiple design lofts with lean angles (Adams (5,971,866, Figs. 3-5)), and clubs with non-design lofts with lean angles (Muldoon (5,421,098, Col. 3, Lns. 8-9)) no longer read on the claims.

30. With respect to item 8, the argument that the combination of Scheie with Thompson is improper since Scheie does not discuss a connection between a head and a shaft and no shaft is depicted anywhere in Scheie is disagreed with. Scheie was not used to show the connection between the head and shaft. Thompson was used for that Scheie was used only to show the teaching that it is known to manufacture heads by forging and casting.

31. With respect to item 9, the argument that the rejection using the reference of Ahn is improper due to Ahn not discussing the desirability of a lean angle is disagreed with. See item 23 above.

32. With respect to item 10, the arguments that the rejection using the reference of Ahn is improper due to no dimensions are given, the ground is not indicated, and only a tiny portion of a shaft is shown and that the figure is an inaccurate rendering of a standard club are disagreed with. Though the ground is not indicated one can easily see that the shaft is not perpendicular to the sole of the head. It appears that the body of the head not including the hosel is to be perpendicular to the page since no top surface, bottom surface, back surface or face surface depth is seen other than at the cross section shown. With respect to the figure being an inaccurate rendering of a standard club it is argued that this accidental disclosure is clearly made in the drawings and is available as a reference. See "In re Seid, 73 USPQ 431" in item 27 above. The disclosure of Ahn combined with the knowledge of what is available as prior art to one skilled in the art as

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discussed in item 26 above, would clearly make it obvious to have a lean angle as one of the possibilities for the club of Ahn.

33. With respect to item 11, the argument that the rejection using the reference of Ahn is improper due to the purported lean angle being outside claimed range for claims 53 or 66 as shown by the Attachment III is disagreed with. The examiner used a protractor for figure 5 of Ahn using the a central axis of the shaft and a line perpendicular to a line including the sole and produced an angle of about 9.5 degrees from a vertical and the axis of the shaft (See appendix 1).

34. With respect to item 12, the argument that the rejection using the reference of Ahn is improper due to examiner discussing Ahn together with a reference by Solhiem in Office Action mailed May 22, 2003 and than the examiner dropping the reference to Solheim in the Final Office Action (11/14/03) which is a telling omission is disagreed with. The examiner in the Office Action mailed May 22, 2003 never combined the references of Ahn together with the reference of Solhiem (3,897,065). In this Office Action the examiner cited Ahn and Solheim separately as prior art made of record and not relied upon. The examiner never tried to argue combining the teachings of both is these references.

35. With respect to item 13, the argument that the rejection using the reference of Ahn is improper since in the Final Office Action (11/14/03) the examiner replaced Solheim

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with Hirose and Hirose discloses a straight shaft and combined with the no lean angle head of Ahn is disagreed with. First the examiner never combined Ahn with Solheim. This Final Office Action was the first time the reference of Ahn was used in a rejection. And it is not agreed that Ahn does not disclose a lean angle. Combining a straight shaft of Hirose with a lean angle of Ahn discloses a club with a lean angle. See items 32-33 above.

36. With respect to item 14, the argument that the rejection combining reference of Ahn and Hirose is improper since one skilled in the art would much more likely select the standard no-lean-angle connection of Hirose rather than the 15 degree "lean angle" of Ahn is disagreed with. A standard no-lean-angle and a 9.5 degree lean angle are both obvious possibilities. Just because one may be more likely it does not mean the use of the other is precluded. One skilled in the art brings different teachings when evaluating clubs in the art and in this case both a standard no-lean-angle and a 9.5 degree lean angle each would be obvious. The drawings of Ahn clearly shows a lean angle and one skilled in the art would consider it and as a minimum specifically choose not to have a lean angle in order to have another option as having a non-lean angle.

37. With respect to item 15, the argument that the rejection using the reference of Adams in view of Hirose is improper since the head presently claimed have a single design loft is disagreed with. The claims rejected using the reference of Adams do not

require the element of structure of a single design loft. The after final amendment of 6 July 2004 was not approved for entry.

38. With respect to item 16, the argument that in the Final Office Action (11/14/03) the examiner did not respond to the Appellant's prior comments with respect to Adams is agreed with. The examiner responded to the argument in the Advisory Action dated 22 March 2004.

39. With respect to item 17, the argument that the cited by not relied reference of D'Amico does not show a lean angle but a golfer using a standard club in a swing that de-lofts the club is disagreed with. Nothing in the reference of D'Amico discloses the concept of delofting a club. In fact the examiner believes the opposite to be true. D'Amico discloses a player properly aligning the club (Abstract), addressing the ball with the head so that the bottom edge or sole is flat on the ground directly in back of the ball (Col. 1, Lns. 49-55), clubs designed to be placed flat on the ground (Col. 2, Lns. 39-44), present invention assisting a player to ensure the head is lying flat on the ground in a proper stance (Col. 2, Lns. 45-66), the golfer can see the ground when the head is back of the ball with the bottom edge or sole of the head being flat on the ground (Col. 3, Lns. 3-14), apparatus enables proper clubface alignment (Col. 3, Lns. 48-50), and proper address with hands ahead of the ball (Col. 4, Lns. 39-50, Fig. 1B). Clearly with a sole flat on the ground, the club face aligned at the address and the hands ahead of the ball (Fig. 1B) the club is going to have a lean angle. Most of the other references cited

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disclose the same concept where the lean angle will place the hands of a golfer ahead of the ball.

40. With respect to item 18, the argument that in the Advisory Action the examiner seems to recognize that D'Amico shows a golfer actively delofting a standard club not a club with a lean angle by the statement "Clearly there is an angle between the shaft and vertical which the golfer is leaning the shaft to" is disagreed to. The more accurate position the examiner takes is that D'Amico discloses a club with a shaft angled from vertical with the sole flat on the ground.

41. With respect to item 19, the argument that the examiner's suggestion that a sole flat for D'Amico would lead to a flat sole with a zero lean angle since the head face and shaft would be unchanged from a standard club is disagreed with. Actually the examiner did not need to suggest a flat sole since D'Amico already discloses it (Col. 3, Lns. 3-13). D'Amico's device works when a club has a lean angle so a player can see the ground with the sole flat on the ground (Col. 3, Lns. 3-13) and hands ahead of a ball (Col. 4, Lns. 42-51). A flat sole and lean angle would not destroy the original intended relationship between the face and sole of a head for a club of D'Amico but achieve exactly what D'Amico is trying to achieve.

42. With respect to item 20, the argument that it is improper to conclude that D'Amico is teaching a lean angle since D'Amico specifically teaches standard long irons in column

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4 lines 42-58 is disagreed with. D'Amico does not use the word "standard" what so ever. He mentions long irons which clearly the advantages of D'Amico would be used for as well as for short irons, wedges, and woods (Abstract).

43. With respect to item 21, the comment that the appellant does not see how adding a lean angle would assist golfers in achieving a repeatable stance is noted. In the Advisory dated 3/22/04 the examiner stated that having a flat sole would assist the golfer in having a repeatable stance. The examiner was discussing this for the stance shown in figure 1B of D'Amico. However since D'Amico already disclosed this (Col. 3, Lns. 3-13) the examiner did not need to stated this. A flat sole helps for repeating a proper stance because normally a golfer will be able to notice when the head is not flat on the ground.

44. With respect to item 22, the argument that the reference of Blough and five by Antonious are not accurate, scaled depictions and as such should not be used to disclose a lean angle is disagreed with. With respect to the figure being an inaccurate rendering of a standard club it is argued that this accidental disclosure is clearly made in the drawings and is available as a reference. See "In re Seid, 73 USPQ 431" in item 27 above. The disclosure of these references combined with the knowledge of what is available as prior art to one skilled in the art as discussed in item 26 above, would clearly make it obvious to have a lean angle as one of the possibilities for these clubs.

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One skilled in the art would consider it and as a minimum specifically choose not to have a lean angle in order to have another option as having a non-lean angle club.

43. In closing, it is the position of the examiner that clubs having lean angles are not new. They are disclosed in prior art by accidental drawings, woods, irons with non-straight hosels, wedge with multiple hosels and shafts, clubs with non-straight shafts, irons with multiple design lofts with lean angles, clubs with hosels which are bent after manufacturing and training clubs on how to properly address a ball with the sole flat on the ground and hands a head of the ball. Prior art even discloses motivation for such as to have the hands ahead of the ball at address. It is the examiner's judgment that this teaching should not be patented.

For the above reason, it is believed that the rejections should be sustained.

Respectfully submitted,

Stephen Blau


STEPHEN BLAU
PRIMARY EXAMINER

August 18, 2004

Conferees

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